

REMARKS

Claim 1 has been amended to incorporate therein the recitation of claim 8, to recite that the capacitor element has roughened side surfaces to increase the adhesion strength between the capacitor element and resin charged into the mold. Claim 8 has been canceled.

Non-elected method claim 9 has been amended to include all of the limitations of amended claim 1 directed to a printed-wiring substrate. Claims 12-14 have been canceled. Rejoinder of non-elected claims 9-11 under MPEP § 821.04 is respectfully requested upon allowance of product claim 1.

Furthermore, if generic claim 1 is found to be allowable, then non-elected species claim 4 including all of the limitations of claims 1 and 2 should also be allowable.

Review and reconsideration on the merits are requested.

In response to the objection to the Drawings, Applicants submit herewith revised Fig. 5(a) showing capacitor element 413 having roughened side surfaces. The modification to Fig. 5(a) conforms the drawings to the description in the specification, as well as to other drawings as originally filed, and no new matter has been added.

Specifically, support is found, for example, by reference to Fig. 1(a) showing capacitor element 13 having roughened side surfaces. See also page 8, lines 3-8 (As described in a fifth aspect (5) of the invention, at least side surfaces of the capacitor element are preferably roughened in order to increase the adhesion strength between the capacitor element and resin charge into a mold. The roughened side surfaces increase the bonding strength between the capacitor element and the resin used for molding the insulating substrate to thereby increase the

rigidity of the insulating substrate); at page 13, lines 7-10 (...at least side surfaces of the capacitor element are roughened in order to increase the adhesion strength...); at page 16, lines 20-22 (Subsequently, the capacitor element 13 having roughened side surfaces is placed in a mold for molding...); and claim 8 of the specification as originally filed.

The Examiner is respectfully requested to approve the drawing changes to Fig. 5(a).

Responsive to the claim objection, claim 7 has been amended as requested.

In response to the rejection of claim 8 under 35 U.S.C. § 112, first paragraph, Applicants respond as follows.

The Applicants were clearly in possession of the claimed invention at the time that the application was filed. Claim 8 as originally filed clearly describes the embodiment where the capacitor element has roughened side surfaces. This particular embodiment of the invention is described in multiple passages in the specification, and is also illustrated in Fig. 1(a).

The Examiner seems to take the position that because Fig. 5 (as originally filed) does not show roughened side surfaces, that in some way Applicants were not in possession of the invention of claim 8. This is unreasonable. It is tantamount to suggesting that Applicants do not have the right to claim an invention comprising the combination of, for example, claims 1, 2 and 8 as originally filed.

If there is any doubt, the specification at page 8, lines 3-12 describes that "as described in a fifth aspect (5) of the invention, at least side surfaces of the capacitor element are roughened...". This is a general description applicable to all aspects of the invention, and there is nothing in this passage which limits roughening of the side surfaces of the capacitor element to

any particular drawing. There is nothing in the specification which says that roughening of the side surfaces of the capacitor element cannot be applied to the embodiment of Fig. 5. Page 8 of the specification describes that the side surfaces of the capacitor element are roughened in order to increase adhesion strength between the capacitor element and resin charge into a mold. This is fully applicable to the embodiment of Fig. 5 which is also prepared by charging a resin into a mold. See page 27, lines 10-12 of the specification. The embodiment of Fig. 5 differs from previous embodiments in that fibers 430 are placed in the mold before disposing the capacitor elements 413 into the mold. However, there is no reason to question whether Applicants had possession of an invention where the side surfaces of the capacitor elements 413 were roughened before placing in a mold and charging resin into the mold.

If the rejection is maintained, then the undersigned requests a personal interview with the Examiner.

Withdrawal of the foregoing rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Claims 1-3 and 6-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,866,952 to Wojnarowski et al. The Examiner considered Wojnarowski et al. as disclosing a printing wiring substrate meeting the terms of the rejected claims.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wojnarowski et al. in view of U.S. Patent 6,153,290 to Sunahara. The Examiner relied on Sunahara as disclosing an insulating substrate having through holes and through-hole conductors formed on wall surfaces of the through holes.

None of the cited references discloses, illustrates, teaches or otherwise suggests a printed-wiring substrate including a capacitor element having roughened side surfaces for increasing adhesion strength between the capacitor element and resin charged into the mold.

For the above reasons, it is respectfully submitted that the claims as amended herein are patentable over Wojnarowski et al., considered alone or in view of Sunahara, and withdrawal of the foregoing rejections is respectfully requested.

Withdrawal of all rejections and allowance of claims 1-7 and 9-11 is earnestly solicited.

In the event that the Examiner believes it may be helpful to advance prosecution of this application, the Examiner is invited to contact the undersigned at the local Washington, D.C. telephone number indicated below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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